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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,153

10/27/2006

Ralf Dunkel

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04/24/2009

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Patent Department

2 T.W. ALEXANDER DRIVE

RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

SZNAIDMAN, MARCOS L

ART UNIT

PAPER NUMBER

1612

MAIL DATE

DELIVERY MODE

04/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,153	Applicant(s) DUNKEL ET AL.	
	Examiner MARCOS SZNAIDMAN	Art Unit 1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 13, 14 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 12, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to applicant's reply filed on March 3, 2009.

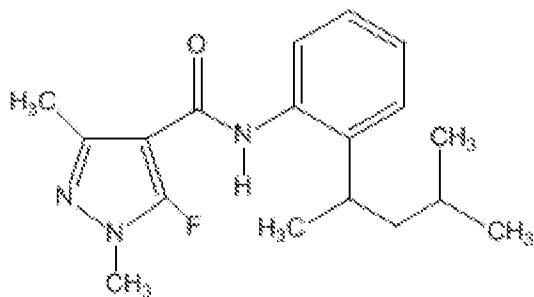
Status of Claims

Claims 11-15, and 17-18 are currently pending and are the subject of this office action.

Claims 13-14 and 18 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 14, 2008.

Claims 11-12, 15 and 17 are presently under examination.

Applicant elected the species corresponding to Example 5 (see specification, Table 1, page 41). In the Office Action mailed on October 29, 2008, the elected species was found free of prior art, so the examination was expanded to the following species:
N-[2-(1,3-dimethylbutyl)phenyl]-5-fluoro-1,3-dimethyl-1H-pyrazole-4-carboxamide
(CAS# 494793-67-8, Compound III):



Compound III

which is currently under examination.

Priority

The present application is a 371 of PCT/EP04/11394 filed on 10/12/2004, and claims priority to foreign application GERMANY 10349502.9 filed on 10/23/2003.

Rejections and/or Objections and Response to Arguments

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated (Maintained Rejections and/or Objections) or newly applied (New Rejections and/or Objections, Necessitated by Amendment or New Rejections and/or Objections not Necessitated by Amendment). They constitute the complete set presently being applied to the instant application.

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Claim Rejections - 35 USC § 103 (New Rejection not Necessitated by Amendment)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

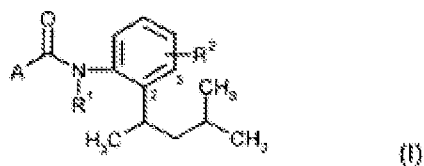
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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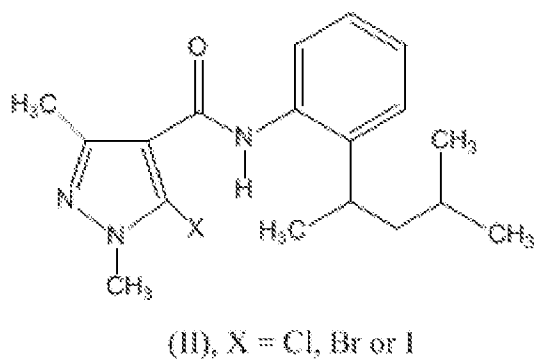
consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elbe et. al. (WO 2003/010149, cited in prior office action).

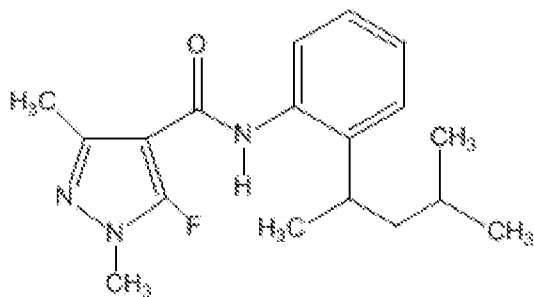
Claims 11-12 and 15 recite a compound of general formula I:



which encompasses compounds of the following general formula II:



For claims 11-12 and 15, Elbe et. al. teach Compound III: N-[2-(1,3-dimethylbutyl)phenyl]-5-fluoro-1,3-dimethyl-1H-pyrazole-4-carboxamide (CAS# 494793-67-8, see page 55, compound I-21):



Compound III

Elbe does not teach the exact compounds encompassed by general formula II above. However Elbe teaches compound III that only differs from the compounds of general formula II by the presence of Fluorine instead of Chlorine, Bromine or Iodine. Substituting one halogen by another, like Fluorine with Chlorine, Bromine or Iodine in organic molecules is a common practice among organic/synthetic chemists. See for example: In *re Gyurik*, 201 USPQ 552, 596 F2d 1012 on page 557 states: “In obviousness rejections based on close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.” In this case, is expected that compounds of general formula II and compound III differing only in the type of halogen would have similar chemical, physical and biochemical properties.

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to replace the Fluorine of Compound III taught by Elbe, with any halogen like: Chlorine, Bromine or Iodine in order to obtain the compounds of General formula II of the instant application, with the expectation that these compounds

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will have similar physicochemical and biological properties (e.g. fungicides) , thus resulting in the practice of claims 11-12 and 15 with a reasonable expectation of success.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elbe et. al. (WO 2003/010149, cited in prior office action) as applied to claims 11-12 and 15 above and further in view of Winston (US 5,496,568).

Claim 17 further limits claim 11, wherein the compound of formula I is in a composition comprising one or more extenders and/or surfactants.

For claim 17, Elbe et. al. further teach that the compounds of their invention, including the species being examined (N-[2-(1,3-dimethylbutyl)phenyl]-5-fluoro-1,3-dimethyl-1H-pyrazole-4-carboxamide (CAS# 494793-67-8, see page 55, compound I-21) are useful as fungicides (see title and English abstract).

Elbe does not teach that the composition comprises one or more extender and/or surfactants. However, Winston teaches that fungicides are normally formulated with surfactants (see column 6, lines 9-11).

At the time of the invention, it would have been *prima facie* obvious for a person of ordinary skill in the art to add surfactants to the elected compound, since these are common ingredients in any fungicidal composition, with the motivation of obtaining a

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better fungicidal action, thus resulting in the practice of claim 17 with a reasonable expectation of success.

Withdrawn Rejections and/or Objections

Claims rejected under 35 USC 102 (b)

Applicant's arguments have been fully considered and are persuasive. The examined compound does not anticipate the compounds of General Formula I.

Rejection under 35 USC 102(b) is withdrawn.

However, upon further consideration, a new obviousness 103(a) rejection is applied based on the

Conclusion

No claims are allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick F. Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/
Examiner, Art Unit 1612
April 23, 2009

/Brandon J Fetterolf/

Primary Examiner, Art Unit 1642